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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/936,840

01/07/2002

Damien Rosney

1890-0018

1494

22204

7590

05/08/2006

NIXON PEABODY, LLP

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EXAMINER

NGUYEN, VI X

ART UNIT

PAPER NUMBER

3734

DATE MAILED: 05/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/936,840

Applicant(s)

ROSNEY ET AL.

Examiner

Victor X. Nguyen

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13 is/are pending in the application.
- 4a) Of the above claim(s) 1 and 6-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/19/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. The request filed on 10/19/2005 for Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 09/936,840 is acceptable and a RCE has been established. An action on the RCE follows.

Election/Restrictions

2. Applicant's election without traverse of Group II, claim 13, Specie 1, Figs. 2-4 in 8/13/2004 is acknowledged.

Claims 1 and 6-12 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a non-elected species, there being no allowable generic or linking claim. Election was made **without traverse** in the reply filed on 8/13/2004.

Specification

3. **Content of Specification**

The disclosure is objected to because of the following informalities: There is no abstract in the specification. Furthermore, there is no heading for the following: 1) Background of the Invention, 2) Summary of the Invention, 3) Brief Description of the Drawings, 4) Description of the Specific Embodiments. Appropriate correction is required.

Information Disclosure Statement

4. The information disclosure statement (IDS) received on 10/19/2005, is acknowledged. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 103

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5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 13 is rejected under 35 U.S.C. 103 (a) as being unpatentable over Brinkerhoff et al. (U.S. 5,366,478) in view of Beane et al (U.S. 5,906,577).

Brinkerhoff et al show in fig. 3, a surgical device for use in minimally invasive surgery having the limitations of claim 13, including: a body cavity engagement means (15) for insertion into the incision to locate the device in position, a fixing means (see col. 5, lines 8-31) for attaching the device to a patient's skin which includes a ring (19,20), where the body cavity engagement means is adjustable so that the positioning of the ring is capable of retracting the body cavity in order to define an access port (17) and creates a sealing means (10) between the incision and the body cavity, and where additional sealing means incorporating a toroid cell (11,13). However, Brinkerhoff et al do not disclose a toroid cell that comprises a bladder filled with one of a liquid and a gel to prevent leakage of gas from the body cavity on inflation.

Beane et al teach the sealing means that comprises a bladder filled with one of a liquid and a gel (fig. 11, see col. 2, lines 20-29 and col. 11, lines 63-67).

It would have been obvious to one having ordinary skill in the art at the same time the invention was made to modify Brinkerhoff et al by making the sealing means incorporating a toroid cell that comprises a bladder filled with one of a liquid and a gel as taught by Beane in

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order to enhance the effectiveness of the seal around the instrument. Furthermore, it helps a surgeon to operate comfortable with his or her hand.

Response to Arguments

6. Applicant's arguments (filed 5/2/2005 and 10/19/2005) with respect to claim 13 have been considered but are moot in view of the new ground(s) of rejection. Applicant is asked to please refer to the modified prior art rejection above where examiner addresses applicant's concerns regarding prior art rejections.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor X. Nguyen whose telephone number is (571) 272-4699. The examiner can normally be reached on M-F (8-4.30 P.M).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anh Tuan Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Victor X Nguyen
Examiner
Art Unit 3731

Vn 
12/19/2005


ANH TUAN T. NGUYEN
SUPERVISORY PATENT EXAMINER